

written statements by the supervisor made sometime after the demonstration fully corroborate Schroeder's description of the demonstration.

Issues

When was the invention "made" within the meaning of Paragraph 1(a) of Executive Order 10096, as amended?

Has Schroeder overcome the presumption of Paragraph 1(c) of Executive Order 10096, as amended?

Discussion

Schroeder contends that he "made" the invention in January of 1982 — prior to the time he used any Government time or facilities to test the invention. To the extent that Schroeder relies on any activity prior to the demonstration to his supervisor in early February of 1982, Schroeder's contention is not corroborated. Nor is there any written description by Schroeder or any other individual of the invention prior to the demonstration.

[2] The record is vague as to the precise nature of the "idea" Schroeder possessed in January of 1982. While the precise time an invention is "made" within the meaning of Paragraph 1(a) of the Executive Order must be decided on a case-by-case basis, under the facts of this case Schroeder has not appropriately demonstrated that he "made" the invention in January of 1982. Something more is needed beyond an uncorroborated statement that an invention was made in a case where there is no contemporaneous description of the invention.

Schroeder's demonstration to his supervisor is corroborated by the supervisor. There was no written description of the demonstration at the time it was made. However, Schroeder's supervisor in documents written sometime after the demonstration, fully corroborates the nature of Schroeder's demonstration and statements made by Schroeder at the demonstration as to what needed to be changed on the demonstrated prototype to make a useful target marksmanship trainer for the Army. By that time, however, Schroeder had used 20 hours of Government time and Government facilities to "make" the invention. On the record in this appeal, it will be assumed that Schroeder "made" the invention upon conclusion of the demonstration to, and discussion of the necessary changes with, his supervisor.

[3] Schroeder has not overcome the presumption to which the Army is entitled un-

der Paragraph 1(c) of the Executive Order. It is true that Schroeder spent 20 hours of his own time in making the invention. However, it is also true that Schroeder spent (and was paid for) 20 hours of Government time in making the invention. Schroeder also used Government facilities to test the invention. It would be curious indeed if a Government employee could decide on his own to use Government time and facilities to test an invention while at the same time contend that he is entitled to title subject to a license to the Government. Compare *Houghton v. United States*, 23 F.2d 386, 390 (4th Cir.), cert. denied, 277 U.S. 592 (1928); *In re Phillips*, 230 USPQ 350, 352 (Comm'r. Pat. 1986). Under the circumstances of this case, it cannot be said that the Government's contribution to the invention (in time and facilities) is insufficient equitably to justify a requirement of an assignment to the Government. See Paragraph 1(b) of Executive Order 10096, as amended.

Decision

The determination of the Army that the Government is entitled to an assignment of all right, title, and interest in and to the above-identified invention is affirmed.

Patent and Trademark Office Board of Patent Appeals and Interferences

Ex Parte Hozumi

Appeal No. 559-94

Decided June 26, 1984

Released May 27, 1987

PATENTS

1. Patent construction — Claims — In general (§125.1301)

Finding that there exists substantial structural feature of class of compounds claimed disclosed as being essential to at least one disclosed utility, e.g., antimycotic activity, supports reversal of final rejection based on alleged improper Markush claims.

Particular Patents — Ethylene Glycol

Serial No. 257,771, Hozumi, Nomura, and Yoshioka, Ethylene Glycol Derivatives, rejection of Claims 1-6, reversed.

EXHIBIT

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tables

Application for patent of Motoo Hozumi, Hiroaki Nomura, and Yoshio Yoshioka, Serial No. 257,771, filed April 27, 1981, for Ethylene Glycol Derivatives. From rejection of Claims 1-6, applicants appeal. Reversed.

Harold C. Wegner and Wegner & Bretschneider, both of Washington, D.C., for applicants.

Before Serota, Katz, Goldstein, Lovell, and Steiner, Examiners-in-Chief.

Goldstein, Examiner-in-Chief.

This appeal is from the examiner's final rejection of claims 1 to 6. Claims 7, 9 and 12 have been withdrawn from further consideration under 37 C.F.R. 1.142(b). Claims 8, 10 and 11 have been indicated as being allowable if rewritten in independent form.

A copy of illustrative claim 1 is appended to this opinion. There are no references relied on by the examiner on appeal. Claims 1 to 6 have been finally rejected as being improper Markush claims. We shall not affirm this rejection.

The judicially created rejection of claims for "improper Markush grouping" has most recently been discussed by the Court of Customs and Patent Appeals (the predecessor to our present reviewing court, the Court of Appeals for the Federal Circuit) in the case of *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980), relied on by the examiner. The opinion in that case fairly thoroughly reviewed the history of this type of rejection and set forth, at least implicitly, some guidelines for determining whether or not a Markush group is proper. Broadly, the determinative factor was held to be whether there existed "unity of invention" or whether the claims were drawn to a collection of "unrelated inventions." Specifically, the claims in that case were drawn to a class of compounds all of which were both disclosed and claimed as being "useful as dyestuffs." All of them were also both disclosed and claimed as being "coumarin compounds." Thus, all of the claims had in common a functional utility related to a substantial, structural feature disclosed as being essential to that utility.

[1] The court was careful to point out that cases of this type are decided on their facts on a case-by-case basis. When we examine the facts in this case, we find that, as was the case in *Harnisch*, there is a substantial struc-

tural feature of the class of compounds claimed disclosed as being essential to at least one disclosed utility, e.g., antimycotic activity. As can be seen from the copy of claim 1 appended to this opinion, the compounds claimed are phosphoric acid diesters in which one esterifying moiety is derived from a poly(ethylene glycol) monoether and the other is derived from a beta-aminoethanol.¹ The molecular weight, i.e., the number of repeating oxyethylene units in the poly(ethylene glycol) ether moiety, can vary over a fairly broad range. The etherifying group can also vary in both molecular size and substitution. Possibly the greatest degree of variation occurs among the permitted substituents on the nitrogen atom of the aminoethanol moiety. The class recited is extremely broad. However, in view of the relatively large proportion of the structure of the compounds in the claimed class which is common to the entire class, we find that the breadth represented by the three above discussed variables does not derogate from the unity of invention in this case.

We wish to reiterate that cases of this type must be considered on a case-by-case basis and that application of the guidelines set forth in *Harnisch* to different facts could result in a different outcome.

Claims 1 to 6 have been finally rejected under the first paragraph of 35 U.S.C. 112 as being based on a non-enabling disclosure. The examiner has catalogued the numerous variations possible within that portion of appellants' structural formula presented by R¹, i.e., the glycol ether moiety, but has not provided any specific reasons to believe that such variations would create any difficulty for one of ordinary skill in the art to prepare the relevant compound using the general synthetic procedures disclosed at pages 3 to 6 and illustrated in the working examples. Thus, there is no evident basis for the examiner's holding of lack of enabling disclosure.

Although it is not perfectly clear, it appears that the examiner's rejection under 35 U.S.C. 112 is also based on an asserted lack of enablement with respect to the utilization of the entire genus disclosed in the antitumor utility disclosed. However, several other utilities are disclosed, and it is not necessary that

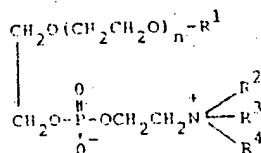
¹ In the claim, the compounds are represented as internal phosphate salts wherein the nitrogen of the aminoethanol moiety is part of an ammonium group. However, for simplicity of description, we have described the structure as though it were the one represented as Formula I' at page 2 of the specification.

all of the compounds claimed be useful for every utility disclosed in an application.

The decision of the examiner is reversed.
REVERSED

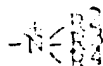
APPENDIX

1. A compound of the formula:



wherein n is an integer of 1 to 15;

R¹ is C₆-26 alkyl, C₆-26 alkenyl or C₆-26 alkynyl, each of said groups being unsubstituted or substituted by hydroxyl, mercapto, amino, oxo, carbamoyl, carboxyl, halogen, C₃-7 cycloalkyl or phenyl; and R², R³ and R⁴ are independently hydrogen or C₁-5 alkyl, or



represents cyclic ammonio selected from the group consisting of pyridinio, oxazolio, thiazolio, pyridazinio, quinolinio, isoquinolinio, N-C₁-4 alkylmorpholinio and N-C₁-4 alkylpiperazinio, each of said groups being unsubstituted or substituted by C₁-4 alkyl, hydroxyl, hydroxyethyl, aminoethyl, amino, carbamoyl or ureido, or a pharmaceutically acceptable salt thereof.

District Court, N.D. California

Ford Motor Co. v. Kuan Tong Industrial Co.

No. C-86-20775 SW

Decided April 16, 1987

TRADEMARKS AND UNFAIR COMPETITION

1. Trademark Counterfeiting Act — Liability (§380.01)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Contempt, sanctions (§410.49)

REMEDIES

Monetary remedies — Attorney's fees; costs — Trademark/unfair competition (§510.0907)

Defendants' sale of counterfeit automotive

accessories, in violation of injunction issued pursuant to Trademark Counterfeiting Act, 18 USC 2320, warrants award to trademark owner of treble damages, based on trademark owner's lost profits, as well as award of costs and reasonable attorney's fees incurred in connection with contempt action.

Action by Ford Motor Company against Kuan Tong Industrial Co. Ltd., Powering Imports Inc., C&H Imports Inc., Simon Huang, Everen Industrial Company, and Chiao Y. Huang, for trademark infringement and counterfeiting, unfair competition, and racketeering. On plaintiff's motion for imposition of sanctions for contempt of preliminary injunction. Sanctions imposed.

David C. Hilliard, Charles R. Mandly, Jr., Debra J. Linn, and Pattishall, McAuliffe & Hofstetter, all of Chicago, Ill.; Harlan M. Richter, Neil D. Greenstein, and Pillsbury, Madison & Sutro, all of San Francisco, Calif.; and Clifford L. Sadler, Dearborn, Mich., for plaintiff.

Paul David Marotta, Jan Adam Greben, and Remer, Dunaway & Schachter, all of San Francisco, for defendants.

Williams, District Judge.

This matter having been heard on March 4, 1987 to determine appropriate sanction for the acts of contempt committed by defendants Powering Imports, Inc., C&H Imports, Inc., Simon Huang and Chiao Y. Huang, the Court makes the following findings of fact and conclusions of law in accordance with Rule 52 of the Federal Rules of Civil Procedure.

I. FINDINGS OF FACT.

1. On October 30, 1986, Ford filed this action for trademark infringement and counterfeiting, unfair competition and racketeering. On that date, in accordance with 15 U.S.C. section 1116(d), the Court issued the Ex Parte Temporary Restraining Order and Order to Permit Seizure. The seizure order was executed by the United States Marshal and large quantities of counterfeit and spurious Ford automotive accessories, namely, wheel covers, wheel cover emblems and decals, were seized.

In relevant part, the temporary restraining order enjoined defendants Powering Imports, Inc., C&H Imports, Inc., Simon